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427 468

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/427,468 04/24/95 FRIESE

A J&J-1500

EXAMINER
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33M1/1008

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ART UNIT	PAPER NUMBER
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DATE MAILED: 3308

10/08/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on 4-15-96, 7-5-96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 9-12, 14-19, 23-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 9-12, 14, 19, 23-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 7-5-96 is ☐ approved ☒ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 39

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

The oath or declaration is objected to for the reasons set forth on page 2, lines 1-9 of a previous Office Action, Paper No. 28.

Applicant's remark's on page 2, first full paragraph of the 7-5-96 response are noted.

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 5, 1996 have been not approved. The proposed changes to Figure 9 are not approved as 12 and 13 are portions of the surface and the proposed changes do not show them as surfaces. Figure 10 is not approved since element 17 as now shown denotes the element already and properly shown as 27.

Applicants remarks bridging pages 1-2 of the 7-8-96 response and page 3, last paragraph of the 4-18-96 response have been considered but are deemed nonpersuasive for the reasons discussed supra.

The drawings are objected to for the reasons set forth on page 2, lines 10-14 of a previous Office Action, Paper No. 28.

The amendment filed August 22, 1994 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: page 3, lines 20-21, page 4, line 27.

Applicant is required to cancel the new matter in the response

to this Office action.

Applicant's remarks on page 4, first two paragraphs, of the 4-15-96 response have been considered. It is Applicant's position that the disclosure of Figures 2 and 4 are clarified by the amendments. See paragraph bridging pages 5-6 and page 6, lines 2-4 of the last Office Action, Paper No. 36. Additionally, see Applicant's remarks on page 5, lines 6-12 of the 4-15-96 response,

PM 9-30-96
i.e. preform has open passages, tampon has ^{closed passages.} ~~yet~~, on page 4, line 27, Applicant describes the tampon, not the preform, may have open passages alone or in combination with closed passages. Also, see page 3, lines 7-9 of the 4-15-96 response ^{where} Applicant, discloses Figure 2 is support for claim 23, i.e. a tampon, rather than a preform. *PM 9-30-96* See also, e.g., page 3, lines 16-17 of the specification. Applicant's own remarks seem to indicate confusion as to what the originally filed specification teaches let alone what it supports.

The specification is objected to for the reasons set forth on page 3, line 11 - page 4, line 2 and page 4, lines 5-9 of a previous Office Action, Paper No. 28. Also, see new matter objection, supra.

Applicant's remarks on page 4, line 21 - page 5, line have been considered but are deemed nonpersuasive because Applicant's own remarks, see discussion supra, indicate confusion as to what the invention is, e.g. open grooves only in preform yet device with open grooves used to support language defining a tampon.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. *9-30* Claim 23 now claims the tampon is free of restrictions to substantial radial expansion. Claim 27 now claims the coarse capillary structure of the ribs is substantially uniform. Claim 28 claims the tampon is capable of substantially uniform radial expansion along the longitudinal direction. On page 3, second and third full *m296* paragraphs, Applicant sets forth the alleged support for such *9-30* amendments. Examiner does not agree. For claim 23, Applicant cites Figures 1-4 and "by implication", page 8a, lines 7-10. However, page 8a, lines 7-10 does not state explicitly or by implication that the expansion is free of restrictions. Figures 1-4 also do not show that expansion, which takes when wetted, e.g., in the body, which is not shown in Figures 1-4, is free of *m296* restrictions. *9-30* Likewise, claim 28 is not supported explicitly or implicitly by page 8a, lines 7-10 or page 1, lines 5-7 which doesn't even describe the present invention. As to claim 27,

"substantially uniform" refers to all directions of the ribs where as Figure 4 only shows the cross-sectional direction.

Claims 9-12, 14-19 and 23-28 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim 10 would be in better form if on line 3, "the" were amended as --its respective--.

Claim 28 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 28, a positive structural antecedent basis for "the longitudinal direction" should be defined.

The claims distinguish over the art because the prior art does not teach the separation amounts as claimed in claim 23 in combination with the other claimed elements ~~not~~ the press dies and forming are as claimed in claim 9.

Applicant's remarks on page 5, line 27 - page 9, last line are deemed moot.

Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617.

K.M. Reichle
KARIN REICHLE
PATENT EXAMINER
ART UNIT 338

K. Reichle:lf
September 29, 1996